



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,451	09/21/2001	Marc O. Schurr	06530.0276-00000	2507

22852 7590 10/31/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

EREZO, DARWIN P

ART UNIT PAPER NUMBER

3731

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/957,451

Applicant(s)

SCHURR ET AL.

Examiner

Darwin P. Erez

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 120, 121, 124, 126, 127, 129-135, 137, 138, 140, 142-157 and 164-167 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/11/06</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4-7,120,121,124,126,127,129-135,137,138,140,142-157 and 164-167.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/11/06 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 5, 7, 120, 121, 124, 126, 127, 130-132, 134, 135, 137, 138, 140, 143-145, 147-155, 157 and 164-167 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,378,010 to Codling et al.

(claims 1, 120, 135, 148) Codling teaches a clip capable for securing a fold of tissue for treating GERD, the clip having a first arm **110** and a second arm **120** disposed substantially opposite from each other; wherein the first and second arms have a first end fixedly connected to each other at bend **140** to define an opening that is capable of receiving a fold of tissue; wherein the first and second arms extend substantially in the same direction as the fold of tissue; wherein the opening allows tissue to extend beyond

Art Unit: 3731

a second end of the first and second arm; wherein the second end of the first and second arms are capable of maintaining a non-contacting relationship when in a deployed state; and wherein the first and second arm includes integral anchoring portions **160,180**, which are projections that are capable of maintaining a non-contacting relationship with the other of the first and second arms during a deployed state. As shown in Fig. 5, the clip can receive a fold of tissue between the openings formed in the arms **110, 120**.

(claims 2, 121, 124, 126, 127, 137, 138, 140, 149-152) The barbs **160,180** of the first and second arms are configured to frictionally engage an outer surface of a tissue. The barbs are also viewed as a reverse angle barb that are located opposite to one another along the first and second arms

(claim 4) Fig. 5 shows a hole **150** capable of receiving an anchoring member.

(claims 5, 131, 132, 144, 145, 154, 155) Fig. 5 shows a tab **110,130** capable of engaging a medical device, wherein the tab extends into the distal end of the first and second arms.

(claims 7, 134, 147, 157) As shown in Fig. 4 and 5, the clip is U-shaped.

(claims 130, 143, 153) The distal ends of the first and second arms are viewed as being tapered away from the gap located at the bend **140** since the first and second arms are flared away from the bend **140**.

(claims 164-167) The clip of Codling is capable of being permanently implantable.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 133, 146 and 156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Codling et al. and in view of US 5,676,676 to Porter.

Codling discloses all the limitations of the recited claims, as shown in the rejections above, but is silent with regards to the clip device comprising bioabsorbable material. However, Porter shows that it is known in the art to use bioabsorbable material to form surgical clips (col. 3, line 46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of Codling with bioabsorbable materials because it would allow the clip to be dissolved within the body and prevent the need of a follow-up surgery to remove the clip.

6. Claims 129 and 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Codling et al. and in view of US 5695,505 to Yoon.

Codling discloses all the limitations of the recited claims, as shown in the rejections above, but is silent with regards to the clip device having an additional anchoring portion, such as a suture. However, Fig. 4 of Yoon shows that it is known in the art for clips to have a suture anchoring portion for piercing tissues. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Codling to include the additional anchoring portion taught

Art Unit: 3731

by Yoon because it provides a more secure attachment of the clip to the tissue, via the pierced and tensioned suture.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 2, 4-7, 120, 121, 124, 126, 127, 129-135, 137, 138, 140, 142-157 and 164-167 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who whose telephone number is (571) 272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Darwin P. Erez
Examiner
Art Unit 3731

de